

REMARKS

Status of the Claims

Reconsideration of this application is respectfully requested. Claims 1, 2 and 5-15 as amended remain in the case and are again presented for consideration. Claim 1 has been further amended to respond to the formal objections raised by the examiner and to otherwise further clarify the recitation of the method of the present invention.

As discussed in relation to the rejection under 35 U.S.C. §112, below, claim 1 has been amended to respond to the examiner's comments. Claim 1 has also been amended to emphasize that the label (42) contacts and adheres to its intended destination, the product container, before it is released from the web that carries it forward to this point. Amendments appearing thereafter in the same claim, provide greater detail as to the disposition of the label with respect to the web and the product container, by stating that "...the relative movement between the web (which is still attached to the label) and the product container (to which the label has just become attached) causes the catch points (that retain the label to the web) to be broken..." and to release the label from the web. The reiteration of this sequence of events within claim 1 is intended to make it clear that the transit of the label from the web to the product container is direct and that the relative movement between the web and the product container alone, causes the separation of the label from the web and facilitates the completion of its application to the product container.

As will be further discussed below, this sequence of events is not disclosed or even made obvious from a consideration of the references of record, whether considered individually or in any conceivable combination.

Response to Arguments

The Examiner's comments regarding applicant's arguments presented in the prior response, appears to accept that the prior art of record, individually, fails to show the invention particularly as presently defined in claim 1. As best understood, the examiner's position appears to the two documents, namely, Boreali and Bekker-Madsen, in combination, show the invention.

Specifically, it is stated that Boreali shows the provision of linerless labels which are separated and placed onto a conveyor for subsequent supply onwards, and Bekker-Madsen allegedly shows the application of labels taken from a backing layer and placed directly onto a product container. The Examiner argues that the skilled person would combine the teaching of these two documents to arrive at the current invention. Applicant submits in response that the Examiner has gone beyond what is a reasonable assumption of what the skilled person would combine to arrive at the current invention, for the following reasons.

In particular, in Boreali there is shown a linerless label supply with break points. In operation, the break points of the leading label are broken to free the same by the burst assembly shown in Figure 6 which includes rolls 19, 20 and 34, 35 and a blade 36. It is the differential in speed between the pairs of rolls 19,20 and 34,35; and the blade which cause the leading label to be separated. Once it is separated the label can be passed onto the conveyor belt or other handling mechanism.

In Bekker-Madsen the leading label is moved to a position at which the last, or rear, break point 54 is broken, as shown in Figure 2, by movement of a cutter 38 to free the leading label. The freed leading label is then capable of being applied to the product or container.

Thus, in both of the prior art documents, a positive, controlled action is required to be performed using additional apparatus provided either via the rollers or cutting mechanism, to free the leading label and it is only after this has been done that the leading label can then be applied to the product or placed on the conveyor.

In contrast, in the present invention, there is no requirement for a pair of rollers or a cutting mechanism to be provided to separate the leading label, as it is the application of the leading edge of the leading label, while that label is still attached to the roll of labels, to the container that causes the break points to be broken and hence frees the leading label from the web. Thus, the application of the leading label to the container occurs before the leading label is freed from the roll of labels and it is the contact and movement of the leading label as a result of the attachment to the container which allows the freeing of that leading label. There is no need

for additional cutting or speed change mechanisms of the type required in the prior art to be provided in accordance with the present invention.

Furthermore, a skilled person would not automatically be able to combine the teaching of the two prior art documents for the following reasons. Boreali relates to pressure sensitive linerless labels whereas Bekker-Madsen depends on applying or activating adhesive after the label is exposed, and it would be impossible to move a pressure sensitive matrix with a beak on the adhesive side of the label which is the equivalent side used to expose the label in the Bekker-Madsen patent.

As already explained above, Boreali uses stress imposed by differential speed rollers and a separation blade to assist in order to separate the labels. Bekker-Madsen uses various punch shapes to cut the break points or ties of the label in the matrix before application. The text of Bekker-Madsen always suggests moving the freed label to a labelling position, never directly to the container.

The examiner in paragraph 2 of the action, posits that the combination of Boreali and Bekker-Madsen is correct as, while the former does not disclose the application of the label directly from a web to a product container, the latter allegedly does. A careful review of Bekker-Madsen (column 2, lines 57-68, column 5, lines 18-37, and accompanying Figures 1 and 2), does not reveal the exact means or progression whereby the labels move from connection to the web directly into contact with the outer surface of a product container. Bekker-Madsen lacks detail or description of such a direct progression and it is submitted, cannot be relied upon for that teaching. Moreover and as been stated previously and above by applicant, Bekker-Madsen does teach that the labels are severed from their web and are then in position for attachment to a product (see column 5, lines 32-36).

More particularly and as stated earlier herein, the teachings of these references are sufficiently distinct from each other that their very combinability is impossible and incorrect. If the references are to be combined, they must first be considered in their entireties for what they disclose, and cannot simply be dissected in search of applicable disclosure for the construction of

a rejection. Such a resultant rejection is flawed.

Without the enabling teaching, applicant submits that Bekker-Madsen fails to provide the requisite teaching upon which the examiner relies, so that the combination of Boreali and Bekker-Madsen is inapt. Withdrawal of the rejections based on the combination of these references is believed to be in order, and is requested.

Claim Rejections – 35 USC §112

Claims 1, 2 and 5-15 have been rejected under 35 U.S.C. §112, second paragraph, regarding particular terms in claim 1.

With respect to the term ‘beak’, this term has been replaced with ‘guide (32)’, which is believed to be consistent with the association presented between the two terms on line 6 of the claim, and the examiner’s comments on this point as well. The term ‘protruding leading edge’ in line 14 is retained, as it is believed to have sufficient antecedent basis from an earlier reference in line 8, that the ‘leading edge (42A)’ (is caused to) “‘protrude’ out of the plane of the web...” Lastly, the term ‘the same’ has been replaced with -- the label --, as this is the understood and intended reference of the objected-to phrase. Applicant’s amendments and comments are supported by the specification and no new matter is believed to be presented hereby. Accordingly, entry and favorable consideration of the amendments to the claims, and withdrawal of the rejection based on 35 U.S.C. §112 is believed to be warranted, and is requested.

Claim Rejections – 35 USC §103

Claims 1, 2, 6 and 8 have been finally rejected under 35 USC § 103(a) over Boreali (US 5,573,621), in view of Bekker-Madsen (US 5,112,427). As this rejection may pertain to the claims as amended, it is traversed.

Applicant’s comments regarding Boreali were stated in the first response to an office action and reiterated in the response filed February 13, 2009, and are repeated again herein in conjunction with the comments responsive to the examiner set forth earlier herein. Accordingly,

the comments in response to the prior office action are repeated below as they are still relevant, even with respect to the examiner's current remarks.

Accordingly, Boreali concerns the processing of what the patentee calls 'non-quadrangle' single-ply labels, and by 'non-quadrangle' the patentee intends labels that are circular, oval, triangular, etc. and thus not square or rectangular (column 1, lines 8-10). Moreover, the labels in Boreali are designed and manufactured to be connected in a 'string', with the 'string' or connection being specifically about 0.018-0.030 inches in width (column 3, lines 43, 61 and 66).

By contrast, the present system and method imposes no such size limitation on either the shape of the labels, or the size of the connections between adjacent label units. This distinction is important as the remainder of the reference is considered.

The Boreali method and system employs three stages of operation. The first is to remove the waste material which surrounds the labels, the second operation is to remove the leading label from the remaining strip of labels and the third operation is to move the *separated* label for subsequent application. The first operation is achieved as shown with regard to Figure 5 and accompanying description, in which there is provided a guide 22 which guides the strip of labels onwards, with the waste material 17 being led upwards as indicated by arrow 30 to be separated from the strip of labels. It is this stage of the Boreali method that continues to be a relevant distinction from the present method.

To reiterate, at this stage of the Boreali method, the strip of labels remains intact and indeed there is no possibility of the leading label being separated, as there is no apparatus provided to do so. This therefore means that in Boreali, downstream of the matrix separation, apparatus for the second operation is required to be provided. This apparatus comprises bursting rollers 34, 35 and a blade 36. This operation separates the leading label and even then, further apparatus is required in order to grab and move the separated leading label for subsequent use. Examples of this apparatus are provided in Figures 7-13 of the reference.

Applicant hastens to point out, that no such apparatus is either necessary or is provided in the practice of the present method, and that instead, the relative movement of the lead label,

already attached to the product container at its forward edge, in relation to the remainder of the label web, results in the severance of the lead label therefrom and its freedom for subsequent movement into complete adhesive contact with the product container surface. Language emphasizing this aspect of the system and corresponding method, has been introduced into claim 1 at lines 20-23 of claim 1.

In summary, Boreali provides and requires three stages of operation using three different sets of apparatus. The examiner has selected to refer to the first stage only, which does not disclose the current invention of claim 1. The examiner then states that it would be obvious to a skilled person reading Boreali to remove all of the apparatus of stages 2 and 3 and then refers to Bekker-Madsen, to provide the requisite teaching. At this juncture, a review of Bekker-Madsen is in order.

The examiner's current remarks rely on Bekker-Madsen for the teaching that the labels may be "... (placed) directly onto the surface of a product container *after separating the labels from a backing material.* " (emphasis added) This is in clear distinction to the present invention, where the label is placed on the product while still attached to the web ('backing material'). Applicant concurs with the remainder of the examiner's statement at this juncture, as she points out that the art (Boreali) teaches the placement of "... *detached* labels on the surface of a product container." Once again, this is in distinction to the instant method, particularly as presently claimed, where the labels are *placed on the surface of (the) product container*, while still *attached* to the web.

Thus, and by the examiner's concurrence, the combination of Boreali and Bekker-Madsen, teaches away from a distinguishing and valuable aspect of the present invention, that the labels travel directly to the surface of the product container while still connected to the web from which they are defined, and only separate from that web after making direct (adhesive) contact with the surface of the product container.

Considering further the disclosure of Bekker-Madsen, this reference concerns a system where a strip of labels is pre-punched with selected portions retained (referred to as 'adhesive

bridges'). In Bekker-Madsen, as in Boreali, the labels reach a station where they are to be readied for application to a container, and at this station they are completely severed from the skeleton of the web. The thus severed labels are then applied by separate mechanisms, such as pressurized air following retention in position by suction.

Importantly, it is clear from Bekker-Madsen that the label is required to be separated from the remainder material before the label is applied to the product container. For example, in column 5, lines 34-36, the label which is to be applied to the container, is stated as being separated and so the label is completely released from the backing material strip and, in column 7, lines 5-14, it is clear that the individual labels are released from the skeleton material strip by the use of punchers or cutters to break the remaining bridges between the label and the other material. In contrast, in the current invention, there is no need to provide punchers, cutters or any other removal device as it is the adherence of the protruding edge of each of the labels on the product container to which the same is to be applied, which causes the remaining bridges between the leading label and the other labels and material to be broken.

As a further point of distinction, in Bekker-Madsen, the adhesive to form the label, is not applied until the label is removed from a backing strip and the label has reached the labeling position; see, for example, column 2, lines 65-69 of the reference. In contrast and as now clearly set out in claim 1 as amended, the label which is applied is a self adhesive label in the current invention and furthermore, no change in condition is required to be performed on the label between movement from the web to the product container. Thus, the label in Bekker-Madsen, is quite clearly not a self adhesive label in the same form as currently claimed. Further, while column 3 of Bekker-Madsen, at lines 10-15, suggests that an inactive adhesive may be provided on the label at all times, there is still required to be performed an action which renders the inactive adhesive, active, before application to the product.

In the present invention it has been identified that it is possible to apply the leading end of the leading label to the product container while still connected to other labels and the surrounding matrix and to allow the relative movement between the container and label to cause

both the separation of the label from the web material and the remaining labels at the same time. This therefore removes the need for two stages of operation of the Boreali method, and achieves a result which cannot be achieved in Bekker-Madsen.

Accordingly, applicant submits that the rejection as it may be based on Boreali in view of Bekker-Madsen is rendered moot by the presentation of the claims as amended, and by the foregoing distinguishing remarks, so that the rejection as it may be based on 35 USC §103(a) is believed to be overcome and withdrawal thereof is requested.

Claim 5, 10, 11 and 12 have been rejected under 35 USC §103(a) as unpatentable over newly cited Boreali in view of Bekker-Madsen, and further in view of Jeffries (US 3,880,692). As this rejection may pertain to the claims as amended, it is traversed.

In similar fashion to the analysis of Jeffries and Boreali in the prior filed response, the former reference likewise fails to cure the deficiencies of the latter even in combination with Bekker-Madsen, as Jeffries concerns itself with the application of adhesive to a surface of a label. In other respects, however, Jeffries fails to disclose that a web of single ply construction bearing a series of labels, all as set forth in claim 1 as amended, could be prepared and used in a method for direct application to a product. Thus, assuming *arguendo*, that the combination of Jeffries, Boreali and Bekker-Madsen et al. is proper, which applicant submits, is not so, it still fails from a factual standpoint, to provide the necessary suggestion to the artisan that the present method as claimed could be arrived at and practiced. For this reason, therefore, the rejection as it may pertain to the combination of Boreali, Bekker-Madsen et al. and Jeffries is believed to be overcome, and withdrawal thereof is requested.

Claim 9 has been rejected under 35 USC Section 103(a) as unpatentable over Boreali in view of Bekker-Madsen, and further in view of West et al. (US 5,275,678). As this rejection may pertain to the claims as amended, it is traversed.

The deficiencies of Boreali and Bekker-Madsen have been pointed out with respect to the rejections discussed above, and such comments are reiterated and incorporated herein. Like Jeffries, West et al. fails to cure the deficiencies of the primary references, as the same teachings

that are missing from the primary references are not supplied by this secondary reference. West et al. is directed to a means by which labels bearing adhesive are treated prior to application so that the adhesive will operatively secure the labels onto containers. There is, however, no disclosure in West et al. of the construction of the labels of the present invention or the specific method by which they are dispensed and conveyed directly into contact with the product container surface. Thus, the combination of West et al. with Boreali and Bekker-Madsen et al. remains deficient and does not provide the requisite teaching to the artisan to arrive at the present invention. Accordingly, withdrawal of the rejection as it may be based on West et al., Boreali and Bekker-Madsen is believed to be in order, and is requested.

Claim 7, 13, 14 and 15 have been rejected under 35 USC Section 103(a) as unpatentable over Bekker-Madsen in view of Osaka (US 6,030,482). As this rejection may pertain to the claims as amended, it is traversed.

Once again, the comments with respect to both Boreali and Bekker-Madsen recited above are incorporated herein by reference and made a part hereof. The deficiencies of Bekker-Madsen are not remedied by Osaka, as Osaka relates only to the application of a silicone layer over the printing or first surface of a label, to act as a release material. There is no disclosure in Osaka of the single layer construction of the present web or the means by which the present labels are directly applied to product containers while still connected to the remainder of the labels. Thus, the rejection as it may be based on the combination of Bekker-Madsen and Osaka is believed to be deficient and overcome, and withdrawal thereof is likewise requested.

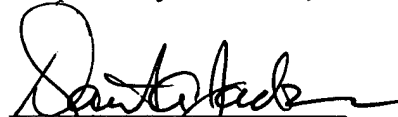
Conclusion

To summarize, therefore, the features of the present method are believed to be more clearly recited in the redraft of claim 1, and upon a review of same, the patentable distinctions between the claim and that of the primary references to Boreali and Bekker-Madsen et al. are made manifestly apparent. Thus, applicants believe that patentable subject matter has now been clearly defined and that all grounds of rejection have been overcome. Should the Examiner

believe that other issues remain for resolution, she is invited to call the undersigned at the number listed below.

In view of the above and foregoing, reconsideration and withdrawal of the outstanding grounds of objection and rejection and early allowance of the claims as amended is believed to be in order and is courteously solicited.

Respectfully submitted,



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ENCLOSURES: Request for one (1) Month Extension of Time
Check No. 5641 in the amount of \$ 65.00